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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,522	04/06/2005	Norbert Heske	289-PDD-03-08 US	6406
96000 7590 12/16/2010 C. R. Bard, Inc. Bard Biopsy Systems 1415 W. 3rd St. Tempe, AZ 85281				
EXAMINER LLOYD, EMILY M				
ART UNIT		PAPER NUMBER		
3736				
NOTIFICATION DATE		DELIVERY MODE		
12/16/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/500,522

Applicant(s)

HESKE ET AL.

Examiner

EMILY M. LLOYD

Art Unit

3736

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 December 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 96 and 111-115

Claim(s) withdrawn from consideration: 97-110 and 116-143

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736

Emily M Lloyd
Examiner
Art Unit: 3736

Continuation of 3. NOTE: Applicant's amendments, see claim 111 ("secondary transmission" amended to "transmission mechanism") and claim 113 (change in dependency from claim 112 to claim 96 and the addition of "wherein the releasable locking mechanism comprises", require further search and/or consideration.

Continuation of 11. does NOT place the application in condition for allowance because: Regarding Applicant's arguments regarding the IDS of 16 July 2010, the Examiner is not charged with understanding Applicant's intent. Applicant is charged with conveying Applicant's intent clearly to the Examiner. Therefore, if Applicant does not clearly convey the intent, the Examiner is left to not consider the reference or to make a guess as to Applicant's intent. The Examiner made an educated guess of Applicant's intent given the information and time available; further, this educated guess was the patent number provided by Applicant. The Examiner notes that US Patent 33258 (entered as 0033258 by Applicant) is different than US Patent RE33258 (which Applicant did not enter). Simply because the Examiner's attempt to help Applicant was not Applicant's intent (which corresponds to a patent number that Applicant did NOT cite) does not mean that the Examiner is at fault. Any consideration of references not previously considered should be made through an appropriate IDS citing the correct patent number(s) as well as other appropriate information as described in the MPEP.

Regarding Applicant's arguments that Dejter does not have a cutting sheath, the Examiner notes that a cutting sheath can be a sheath for cutting tissue or a sheath for covering a cutter, and Dejter teaches the latter.

Regarding Applicant's arguments that Dejter does not teach that the tension slide is brought into a cocked position against the action of a spring by the power source and then further locked in the cocked position, the Examiner disagrees. The Examiner notes that Applicant's arguments appear to be based, in part, on Applicant's assertion that Dejter is not cocked such that release from the cocking position results in taking a biopsy; however, the Examiner notes that Applicant only claims "wherein the tension slide is brought into a cocked position against the action of a first spring by the power source, the tension slide being locked in the cocked position by a releasable locking mechanism" with respect to the "cocking position" and "locked in the cocked position" argued. The Examiner notes that the dictionary defines "to cock" as "to set (a device, such as a camera shutter) in a position ready for use"; the Examiner notes that "for use" can include any use that the components have, including those before, during and after the actual cutting and/or suctioning of tissue, as Applicant has not further claimed that the "cocked position" is related to a particular use/step performed by the device. In other words, Applicant's arguments appear to be based on limitations not claims, i.e. that the tension slide and/or other elements are configured to take a biopsy sample after the tension slide is released from the cocked position. The Examiner notes that the tension slide can be placed in a cocked position for other reasons (for example, to clear a probe after sampling) and still meet Applicant's current claim language.

The Examiner further notes that Applicant summarized Dejter as "Dejter discloses that a forward thrust ... is performed by actuation of the solenoid 70 against return springs 61... and a return reciprocation to the home position is performed under the bias of return springs 61 when the solenoid 70 is deactivated." (page 15 of Applicant's 7 December 2010 arguments). The Examiner notes that this summary corresponds to Applicant's claim 96 limitations "wherein the tension slide is brought into a cocked position against the action of a first spring by the power source ("that a forward thrust ... is performed by actuation of the solenoid 70 AGAINST return springs 61" page 15 of Applicant's 7 December 2010 arguments, emphasis added), the tension slide being locked in the cocked position by a releasable locking mechanism ("and a return reciprocation to the home position is performed under the bias of return springs 61 when the solenoid 70 is deactivated" page 15 of Applicant's 7 December 2010 arguments)" as the solenoid is operated and powered by a power source, and as "when the solenoid 70 is deactivated" indicates that at least the solenoid holds/locks the tension slide in the cocked ("forward thrust") position until at least the force from the solenoid is released/deactivated. The Examiner therefore notes that Dejter still discloses Applicant's claimed limitations; further, it appears that Applicant's arguments are not based on the broadest reasonable interpretation of the claims.